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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,621	08/22/2000	Farzad Hiri	4397.32	9076

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ERICSSON INC.  
6300 LEGACY DRIVE  
M/S EVR C11  
PLANO, TX 75024

EXAMINER

ELAHEE, MD S

ART UNIT PAPER NUMBER

2645

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/643,621	<b>Applicant(s)</b> HIRI ET AL.	
	<b>Examiner</b> Md S Elahee	<b>Art Unit</b> 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9-19 and 21-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-19 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of: \_\_\_\_\_
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed on 05/13/04. Claims 1-7, 9-19 and 21-24 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-7, 9-19 and 21-24 have been fully considered but they are not persuasive.

Regarding claim 1, the Applicant argues on page 7, lines 17-21 that 'the examiner fails to point to any teaching in Gregorek where a user of a called party device causes the sending of a message to a first calling party device using an input mechanism associated with said called party device while the called party device is in communications with a second calling party device". The examiner disagrees with this argument. It is because, Gregorek teaches that after the called party places the first calling party on hold, the first calling party will receive voice announcements until the second telephone 20 reconnects to the first telephone 12. It is clear that placing the first telephone on hold is caused by user of a second telephone and such action causes the first telephone receiving audio announcements (col.16, lines 20-45). Further, such action is being inherently done by an input mechanism associated with the called party device. Thus, Gregorek does teach the claimed limitation "a user of a called party device causes the sending of a message to a first calling party device using an input mechanism associated with said called party device while the called party device is in communications with a second calling party device". Thus the rejection of the claim in view of Gregorek remain.

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore the examiner has given the claim language its broadest reasonable interpretation.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 7, 13-16, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gregorek et al. (U.S. Patent No. 5,557,658).

Regarding claims 1 and 13, Gregorek teaches establishing a first call link between the called party device and a first calling party device (abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4).

Gregorek further teaches receiving a call request to the called party from a second calling party (abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4, col.15, lines 32-56).

Gregorek further teaches placing the first call link on hold (abstract; col.4, lines 4-8, col.15, lines 32-56, col.16, lines 20-45).

Gregorek further teaches accepting the call request from the second calling party device to establish a second call link between the called party device and the second calling party device

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(abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4, col.15, lines 32-56, col.16, lines 20-45).

Gregorek further teaches causing, through signaling the switch 22 (i.e., selective activation) by the user of the called party device, an announcement to the first calling party device, the step of causing an announcement to the first calling party device comprising the step of the user selecting one of a plurality of customized announcements (i.e., predefined messages) using an input mechanism associated with the called party device while the called party is in communication with the second calling party, whereby the user of the called party device can communicate information to a user of the first calling party device without interrupting communications with a user of the second calling party device (abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4, col.15, lines 32-56, col.16, lines 20-45, col.19, line 53-col.20, line 14; 'announcement' reads on the claim 'message to be transmitted'). (Note; The called party selects a customized announcement based on the network address of a calling party. Therefore, when the called party signals the switch 22, the customized announcement is played to the calling party on hold (see col.19, line 53-col.20, line 14))

Regarding claims 2 and 14, Gregorek teaches the message instructing the user of the first calling party device to hold (abstract; col.3, lines 61-67, col.4, lines 1-29, col.8, lines 26-67, col.9, lines 1-4, col.15, lines 32-56, col.16, lines 20-45).

Regarding claims 3 and 15, Gregorek teaches the message instructing the user of the first calling party device that the call link to the called party device will be disconnected (abstract; col.3, lines 61-67, col.4, lines 1-29, col.16, lines 20-45).

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Regarding claims 4 and 16, Gregorek teaches the message automatically causing the first call link to be terminated (fig.3; col.4, lines 1-29, col.11, lines 60-67, col.12, lines 1-5, col.15, lines 32-56, col.16, lines 20-45).

Regarding claims 6 and 18, Gregorek teaches that the first calling party device to be connected to a message generator associated with the user of the called party device (col.4, lines 1-29, col.9, lines 46-54, col.15, lines 32-56, col.16, lines 20-45; 'message generator' reads on the claim 'messaging system').

Regarding claims 7 and 19, Gregorek teaches the message comprising a prerecorded voice message (col.11, lines 16-31, col.15, lines 32-56, col.16, lines 20-45).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent No. 5,557,658) and in view of Rogers et al. (U.S. Patent No. 5,946,386).

Regarding claims 5 and 17, Gregorek fails to teach "said message instructs said user of said first calling party device to leave a message". Rogers teaches that the message instructs the first calling party device to leave a message (col.13, lines 40-44). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek to allow message instructing the user of the first calling party device to leave a message as taught

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by Rogers. The motivation for the modification is to have doing so in order to store the message for the later retrieval.

7. Claims 9, 10, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent No. 6,167,119) and in view of Bull et al. (U.S. Patent No. 6,498,841).

Regarding claims 9 and 21, Gregorek fails to teach “generating a text message using an input mechanism associated with said called party device”. Bull teaches generating a text message using a text to speech module associated with the called party device (col.3, lines 38-67, col.4, lines 1-11; ‘text to speech module’ reads on the claim ‘input mechanism’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek to allow generating a text message using an input mechanism as taught by Bull. The motivation for the modification is to have the generation in order to provide transmitted characters which make up the body of a message.

Regarding claims 10 and 22, Gregorek fails to teach “converting said text message to speech”. Bull teaches converting the text message to speech (col.3, lines 38-67, col.4, lines 1-11; ‘text to speech module’ reads on the claim ‘input mechanism’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek to allow converting the text message to speech as taught by Bull. The motivation for the modification is to have the conversion in order to produce broad, unrelated and unpredictable vocabularies.

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8. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent No. 5,557,658) and in view of Tatchell et al. (U.S. Patent No. 6,160,877).

Regarding claims 11 and 23, Gregorek fails to teach “call links between said called party device and said calling party devices are established through a packet-switched communications network”. Tatchell teaches that the signaling link is established through a packet switched network (col.6, lines 51-60; ‘signaling link’ reads on the claim ‘call links between said called party device and said calling party devices’ and ‘packet switched network’ reads on the claim ‘packet-switched communications network’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek to allow call links be established through a packet-switched communications network as taught by Tatchell. The motivation for the modification is to have the packet-switched communications network in order to carry data in the form of packets.

9. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (U.S. Patent No. 5,557,658) and in view of Tatchell et al. (U.S. Patent No. 6,160,877) and further in view of Zhakov et al. (U.S. Pub. No. 2003/0021264).

Regarding claims 12 and 24, Gregorek in view of Tatchell fails to teach “call links are established using an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP)”. Zhakov teaches that call links are established using a Session Initiation Protocol (SIP) (page no.3, paragraphs 0034-0035; ‘Session Initiation Protocol (SIP)’ reads on the claim ‘an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP)’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregorek



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in view of Tatchell to allow call links be established using a Session Initiation Protocol (SIP) as taught by Zhakov. The motivation for the modification is to have the Session Initiation Protocol for creating, modifying and terminating communication sessions with one or more participants.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Zahaviet al. (U.S. Patent No. 6,577,859) teach Cellular phone system with outgoing message selection system and Grossman (U.S. Patent No. 6,122,346) teach Telephone on-hold response system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703)305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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M.E.

MD SHAFIUL ALAM ELAHEE

November 24, 2004



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600